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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/076,409 05/12/98 WALKER

J WD2-97-563

022927
WALKER DIGITAL
ONE HIGH RIDGE PARK
STAMFORD CT 06905

LM01/0105

EXAMINER

SMITH, D

ART UNIT

PAPER NUMBER

2763
DATE MAILED:

01/05/00

01/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/076,409

Applicant(s)
Walker et al

Examiner
Demetra R. Smith

Group Art Unit
2764



☒ Responsive to communication(s) filed on Oct 13, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-59 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-59 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5 AND 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Part III DETAILED ACTION

Information Disclosure Statement

1. The prior art submitted on 11/29/99 has been considered as indicated on the enclosed copies of form PTO-1449

Response to Arguments

2. Applicant's arguments filed 10/13/99 have been fully considered but they are not persuasive.

Applicant argued that claims 1-59 are statutory because they produce a "useful, concrete and tangible result."

In response to applicant's arguments, claims 1-59 are not statutory. In reference to State Street Bank & Trust Co. v. Signature Financial Group, Inc., 47USPQ2d 1596 (Fed. Cir. 1998), the Signature Financial Group, Inc. patent reference, Boes 5,193,056, claims entail an apparatus (a data processing system). The claims did not calculate a value and the claims did not produce a calculation. However, the apparatus processed data and allocating the percentages of each fund within the portfolio. In addition, the claims were practical because the apparatus shift money around in different funds within the portfolio.

However, applicants claims are method claims that are not sufficient to meet the requirements of physical act, because they are grounded in the abstract idea of physically performing mathematical manipulations of data ("the purchase price") that is simply printed out,

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or outputted out in a signal form. Therefore the claims are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-59 are rejected under 35 USC § 101 the claimed invention is directed to non-statutory subject matter.

A review of the disclosure does not show a practical application within the technological arts. The claims are directed to a determining an upsell and generating a coupon.

An evaluation of these steps does not show that the process performs independent physical acts. The process step of “generating a purchase price”, “generating a rounded price”, “calculating a round-up amount”, “determining an upsell”, or “outputting a signal”, are not sufficient to meet the requirements of physical acts, because they are grounded in the abstract idea of physically performing mathematical manipulations of data. In this regard, the claims merely manipulate data using an abstract mathematical algorithm without any limitation to a practical application within the technological arts.

Conclusion

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5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Demetra R. Smith**, whose telephone number is (703) **308-6989**. The examiner can normally be reached on Tuesday-Friday from 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by phone fail, the examiner's supervisor, **Kevin J. Teska**, can be reached at (703) **305-9704**. Additionally, the fax phone for Art Unit 2764 is (703) **308-9051 or 308-9052**, (for formal communications intended for entry), or (703) **308-5397** (for informal or draft communications, please label "PROPOSED" OR "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**Demetra.Smith@uspto.gov**].

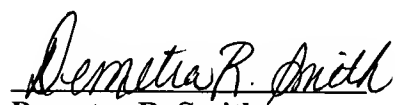
All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-3900.

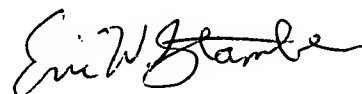


Demetra R. Smith

Patent Examiner

Group Art Unit 2764

December 23, 1999



ERIC W. STAMBER
PRIMARY EXAMINER